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Robert van der Zijpp

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RENNER OTTO BOISSELLE & SKLAR, LLP  
1621 EUCLID AVENUE  
NINETEENTH FLOOR  
CLEVELAND, OH 44115

EXAMINER

WOODS, ERIC V

ART UNIT

PAPER NUMBER

2628

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/626,163	VAN DER ZIJPP, ROBERT	
	<b>Examiner</b>	<b>Art Unit</b>	
	Eric Woods	2672	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 19 January 2006.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-19 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)             | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date _____   | 6) <input type="checkbox"/> Other: _____                                    |

## **DETAILED ACTION**

### ***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 30 December 2005 has been entered.

### ***Response to Arguments***

Applicant's arguments, see Remarks pages 1-2 and the amendments, filed 30 December 2005, with respect to the rejection(s) of claim(s) 1-19 under 35 USC 103(a) have been fully considered and are persuasive.

Therefore, the rejection of claims 1-19 under 35 USC 103(a) stands withdrawn in view of applicant's amendments.

New grounds of rejection against claims 1-19 under various grounds in light of various references follow below.

Applicant has not specifically defined the term 'template'. Therefore, examiner is defining it by synonym: that is, when the word 'template' is looked up in a dictionary, the first entry that comes up is 'pattern'.

Examiner must interpret claim language *prima facie* (that is, the operable assumption is that a term is given its ordinary, customary meaning (Brookhill-Wilk 1, LLC v. Intuitive Surgical, Inc., 334 F.3d 1294, 1298, 67 USPQ2d 1132, 1136 (Fed. Cir.

Art Unit: 2628

2003)) absent either a redefinition of the term by applicant (*Vitronics Corp. v. Conceptor Inc.*, 90 F.3d 1576, 1582, 39 USPQ2d 1573, 1576 (Fed. Cir. 1996) which has not happened – standard set forth in *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999 and *Multiform Desiccants Inc. v. Medzam Ltd.*, 133 F.3d 1473, 1477, 45 USPQ2d 1429, 1432 (Fed. Cir. 1998)) or another, standard meaning in the art) according to *Phillips v. AWH Corp.* (75 USPQ2d 1321 (CA FC 2005)), while giving it the broadest reasonable interpretation (*In re Morris* (CAFC) 44 USPQ2d 1023) that can be sustained in light of the specification (*Phillips v AWH*), wherein dictionaries can be used to ascertain the “ordinary and customary meaning” of a term so long as it is consistent with the usage in the specification (that is, it does not contradict the intrinsic record), particularly during the examination process, where applicant has an opportunity to amend the claims to define terms (*On Demand Machine Corp v Ingram Industries, Inc, et al* (CAFC 2006, appeal 05-1074,-1075, -1100, decided 3/31/2006).

The term ‘template’ is therefore replaceable with ‘pattern’ without further comment.

It is submitted that clauses (b) and (c) in claim 1 are redundant. The terms ‘pattern’ and ‘template’ are regarded to be the same.

Note the following clauses (differences highlighted in bold):

Clause (b)

Selecting a pattern wherein said pattern comprises a multiplicity of cells, each cell having  $n$  regions wherein  $n$  is the number of prepared base images and wherein each region of a cell is assigned to a different prepared image;

Clause (c)

**Providing a merged image** template wherein said template comprises a multiplicity of cells, each cell having  $n$  regions wherein  $n$  is the number of prepared based images and wherein each region of a cell is assigned to a different prepared base image;

Difference 1 is between the words 'selecting' and 'providing', which have the same results and same functional equivalencies, in that if a template or pattern is selected, it will then be applied to the prepared base images, and does not need to be provided, since such a template would be identical to the selected 'pattern' above.

Difference 2 is the words 'merged image' preceding template in clause (c). This recitation is merely a recitation of intended use. There are no other 'templates' in the claims. 'Merged image' merely recites the desired end use, and as such, even though it is in the body of the claim, can be ignored (*Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305, 51 USPQ2d 1161, 1165 (Fed. Cir. 1999)). In the end, in the context of the claim, since there is only template recited, that recitation is meaningless.

Therefore, the clauses are identical.

### ***Allowable Subject Matter***

The potentially indicated allowability of claims 1-19 as discussed during a series of conversations in the months of March and April cannot be held in view of the newly

discovered reference(s) to Carter. Rejections based on the newly cited reference(s) follow.

The proposed examiner's amendments would not put the claims in condition for allowance after this particular reference was found. The proposed limitations are taught by the reference of record. See the rejection to claim 2, and the non-overlapping limitation is discussed in the rejection to claim 1.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim 1-2, 4-8, and 11-12 are rejected under 35 U.S.C. 102(e) as being anticipated by Carter (USPN 6091482).

As to claim 1,

A computer implemented process for the creation of a merged image comprising the steps of: (Preamble is not given patentable weight, since it only recites a summary of the claim and/or an intended use, and the process steps and/or apparatus components are capable of standing on their own; see *Rowe v. Dror*, 112 F.3d 473, 42 USPQ2d 1550 (Fed. Cir. 1997), *Pitney Bowes, Inc. v. Hewlett-Packard Co.*, 182 F.3d 1298, 1305,

51 USPQ2d 1161, 1165 (Fed. Cir. 1999), and the like.)(Carter creates merged images – see Figure 4B and the abstract)

- a. Preparing at least two base images in digital format; (Carter Abstract, Figure 5, 3:30-53, 5:50-60)
- b. Selecting a pattern wherein said pattern comprises a multiplicity of cells, each cell having  $n$  regions wherein  $n$  is the number of prepared base images and wherein each region of a cell is assigned to a different prepared base image; (Figure 6, implemented in Figure 4B, 6:46-58, 7:62-65 ... 'predetermined, **desired** sequence')
- c. Providing a merged image template wherein said template comprises a multiplicity of cells, each cell having  $n$  regions wherein  $n$  is the number of prepared base images and wherein each region of a cell is assigned to a different prepared base image; (This step is identical to the one above, where the template is that shown in Figure 6 and implemented in Figure 8; the template shown clearly divides each image into various image sections (such a template would be defined in Figure 7 particularly, in the regions listed as 20A and 20B))
- d. Applying the pattern to each base image to divide each base image into a plurality of cells each having  $n$  regions; (Carter Figure 7, template is applied to each image, where each image is already divided into columns (Figure 5), 6:43-7:10)
- e. Selecting a mergable portion of each respective base image wherein the mergable portion corresponds to each region of each cell assigned to the respective base image; (Carter Figure 6 teaches of applying the sequence shown in Figure 6 to each underlying base image, such as shown in Figure 8, 7:1-45)

f. Consecutively merging of only the selected mergable portions of each respective base image into the merged image template to provide a single layer merged image. (Carter clearly teaches that a final merged image is generated in Figure 9. Clearly, since the base images are numbered in a left to right manner, the merging process will be consecutive, since the final image is composed from left to right in numbering, and the first image is on the left. This is an inherent property of the merging process shown in Carter. See 7:1-8:45)(Note that Carter does **not** merge cells in an over-lapping manner to anticipate a potential limitation previously brought up during the examiner's amendment discussion).

Carter teaches all the limitations of the above claim, and does explicitly teach that each base image is divided into cells (lenticules) as shown in the drawings (Figure 7, particularly). Such division would be necessary for the functioning of the invention.

As to claim 2, clearly Carter teaches that the number of regions of each cell of respective base image is clearly varied based on the number of base images to be merged, as in 7:25-43 and 5:35-40; since the number of cells and number of items per cell for the merge pattern or template are varied based both the number of base images as specified therein.

As to claim 4, Carter clearly teaches using a computer to perform the steps of the process (Figures 1-2, 2:30-3:40).

As to claim 5, Carter clearly applies a grid, as shown in Figures 5-8.



As to claim 6, Carter clearly divides each base image into pixels, as shown in Figures 5-8 in a digital manner. Next, the base images are clearly divided into cells using a grid pattern, as shown in Figure 7, with the segmentation pattern shown in Figure 6 used to generate the multiplicity of cells and regions; see Figure 7.

As to claim 7, clearly Carter in 5:50-6:20 teaches that the dimensions of the base image or the dimensions of the merged image that is required by a user determine the dimensions of the grid.

As to claim 8, clearly Carter in 7:24-43 and 5:35-40 teaches that the dimensions of the cells are varied based on the number of base images.

As to claim 11, clearly Carter teaches in Figures 5-9, particularly Figures 7-9, that the mergable portions of each base image are placed in a predetermined spacing in relation to each other – namely, the grid template illustrated in Figures 6, 7, and 9.

As to claim 12, Carter teaches that a computer merges the images to form a final, composite image. Clearly, a final composite image that consists of all the various base image portions must be a single layer, since it is sent to the printer as such 8:5-15, 7:10-25 ('final composite image') as a single layer.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Carter et al (USPN 6091482).

As to claim 3, Carter clearly shows in Figures 6 and 8 that the merging template applied uses three cells from some of the base images, which is for an example using four base images (as shown in Figure 5), where  $n$  would be four and  $n$  minus one would be three. This is further a matter of design choice, which Carter clearly teaches in 7:24-43, 5:35-40, the shown Figures, 8:54-9:15, and the fact that the CCPA held that aesthetic design choices cannot be relied upon to distinguish the claimed invention from the prior art (*In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947), which precedent was **not** overruled by *In re Dembiczak*). Applicant has further not presented any evidence of criticality of the number of cells per base image as recited in the dependent claim.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Carter to utilize  $n-1$  cells as recited above for the reasons listed above, and because if the desired composite image must have the same dimensions as the base images, some portion of each base image must be discarded,

Art Unit: 2628

which is the principle used in the art (Carter) and relied upon by prior art of record (Delhi, Atkinson).

Claims 9-10 are rejected under 35 USC 103(a) as unpatentable over Carter as applied to claim 6 above, further in view of Delhi (US 5,638,158).

As to claim 9,

A process as claimed according to claim 6, wherein the cells and regions have a particular shape chosen to achieve or maintain high tolerance with regard to pixel or cells and region spacing.

Reference Carter does not expressly teach this specific limitation. Reference Delhi teaches (9:26-32) that high tolerance with regards to pixel spacing is important. Delhi further teaches that streaks are to be avoided in creating these mosaic images (9:18-29), and various shapes are shown in Fig. 1 where spacing is clearly important. Also, it is a fundamental of the art and geometry that the use of square or rectangular pixels maximizes the spacing (e.g. leaves no empty space), which is usually the goal of a display (to get maximum resolution on it). Further, cells are taught to have different shapes by Delhi (10:1-25). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the digital image displays of Carter with the differently shaped cells and high space tolerance of Delhi, as Carter uses mosaiced base images with no overlap. One of ordinary skill in the art at the time the invention was made would look to the Delhi reference since Delhi is concerned with combining base images into a composite image, and motivation for such a combination

can be found as above, and in Delhi 7:4-20, where it is taught that the **shape** of each particular region or aperture may be configured by the user, which would clearly allow for the user to configure the shapes of the various portions or strips of the lenticular mask of Carter – this would be both advisable, since Carter also suggests it (7:24-43) because the lens spacing could be different, and the lenses could be of non-vertical orientation (e.g. diagonally oriented lenses, which are well known in the art, see

As to claim 10,

A process as claimed according to claim 6 wherein one or more of the base images are divided into differently shaped cells and regions.

Delhi explicitly teaches this limitation, teaching hexagonal, elliptical, and other shapes of pixels / regions (10:1-25). It would trivially obvious to modify the digital displays of Silvers to use the differently shaped pixels / interleaving patterns of Delhi. The motivation and combination of claim 10 are adopted herein by reference without further comment being required.

Claim 13 is rejected under 35 U.S.C. 103(a) as unpatentable over Delhi in view of US 6,088,018 ('DeLeeuw I').

As to claim 13,

A process as claimed according to claim 12 wherein at least one additional layer is added to the single layer image, the entire additional layer being digitally transparent except for advertising material such as trademarks and other digital information, for example Vernier scales, calibration scales, or image borders.

Reference Carter teaches the use of a grid, which would *prima facie* be transparent except for the grid lines dividing the cells for the light sources as specified therein.

Reference DeLeeuw I clearly teaches the use of digitally transparent layers, as shown in Fig. 2, where it is disclosed that a clock and stock ticker are overlaid onto the normal screen, but in a transparent fashion (the stock ticker and clock could obviously be advertising)(4:15-35, transparent layer). Reference Carter clearly teaches use of lenticular images for advertising and similar functionality (1:5-2:20). It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the transparent digital layers of DeLeeuw I with the mosaic techniques of Delhi, as DeLeeuw uses transparent layers and digital processing (*prima facie* digitally transparent) techniques, and with such techniques and the varying interleaving patterns allowed, it would be obvious to use advertising for such a technique. Motivation for combination with the other references is found in the fact that overlaying additional information allows more data to be presented to the user simultaneously (note, for example, the clock and other details in DeLeeuw, and the image of the user shown on the screen, which clearly would allow the user to see his own representation during a video-conference or the like, as discussed, in the reference as above. Therefore, such a modification would have been obvious to one of ordinary skill in the art at the time the invention was made. Further, DeLeeuw is only relied upon for that one particular detail, and thus arguments that such a combination would destroy the function of one reference are not valid, since all references – namely Carter and DeLeeuw – are

software and software can be made of modules that have arbitrary functionality, so it would be obvious to take only the module performing that function and move it to the combination as set forth above.

Claim 14 is rejected under 35 U.S.C. 103(a) as unpatentable over Carter as applied to claim 1 above and further in view of Yokomizo et al (US PGPub 2002/0067500 A1)('Yokomizo') and Morris (US PGPub 2003/0200268 A1)('Morris').

As to claim 14,

A computer network based process comprising the steps of:

- A. At least one end user supplying at least two base images to an image interrogation means; (Yokomizo 0014-0015 and 0048; Morris 0004-0008 and 0010-0011)
- B. The image interrogation means checking the base images for suitability and size; (Yokomizo 0030; Silvers teaches checking the source images and segmenting them as set forth in various earlier claims.)
- C. Implementing the computer implemented process according to claim 1; and (clearly the rejection to claim 1 sets this limitation forth adequately, and that rejection is herein incorporated by reference in its entirety)
- D. Forwarding the merged image to the end user. (Yokomizo Fig. 1, which clearly illustrates that images are processed on the remote server representing the dealer's head office, e.g. element 9. See also Morris 0018-0021)

The parent references (from claim 1) do not expressly teach these limitations. The system of Yokomizo involves having the images from digital photographs stored on a remote server, and the user downloads a small version of the high-resolution image, performs operations on it, and sends the results back to the server, where the server actually performs the desired operations (clips, cuts, rotations, scaling, zooming, image extraction, matte and color correction, sharpening, red eye processing, etc. [0030]) on the high-resolution version. Reference Morris provides a means for users to store their images remotely on a server and share them with other people, including emailing them. The system of Yokomizo [0048] can also provide files after the image processing done remotely [0050] by CD, floppy, etc., and could just as easily be emailed out as the system of Morris does. The only constraint on the Yokomizo system is bandwidth, so with high bandwidth available (e.g. cable modem, DSL, etc.) using the remote server for near real-time image processing applications becomes feasible. Using the technologies of Morris would allow the results to be sent back to the user via email or a website and allow the user to share their work with others. Since the high-resolution images are / would be processed remotely, obviously they would be scanned (Yokomizo) and validated beforehand, but it would be an obvious modification if sufficient bandwidth were available to do the image validation on the remote server upon upload using either the logic behind why it would be done in the first place at scan time of Yokomizo.

Reference Carter teaches the use of processed mosaic images in advertising. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the mosaics and overlays of Carter with the image processing

systems of Morris and Yokomizo, since after mosaic images were rendered, they could be sent back to the end user for review, which would happen using the photo-sharing technology of Morris or email, where allowing the user to verify the acceptability of the finished product before final printing would be sufficient benefit to justify this combination.

Claims 15-16 are rejected under 35 U.S.C. 103(a) as unpatentable over Carter as applied to claim 1, in further view of Yokomizo and Morris as applied to claim 14, and further in view of Kimura et al (US PGPub 2003/0025933 A1)('Kimura').

As to claim 15,

A computer network based process as claimed according to claim 14 wherein the base images are forwarded to an interrogation means which then forwards the base images to a third party for the application of the process for the creation of the merged digital image.

References Carter and Morris do not explicitly teach this limitation. Reference Yokomizo implicitly teaches this limitation, where the user brings their photographs to the dealer branch shops (Fig. 1) and the dealer then scans them and sends them to the dealer head shop. Obviously, such dealer shops could be franchises that were independently owned, and the dealer head shop would be an effective third party, and users could upload pictures to the dealer shops rather than physically bringing them in.

Reference Kimura explicitly teaches this limitation, wherein in 0019-0021 and Fig. 4 Kimura teaches that users can observe an image that they want, download a



thumbnail, place an order for said image (taken from, for example, a sporting event by a TV station or professional photographer), pay for said image, and then send it to a "photo finishing" location where it will be processed as they desire (e.g. zoomed in, blown up, rotated, scaled, cropped, etc.) and the final product sent to them (obviously, it could be downloaded [0089] or sent to them via mail or email (see technology of Morris)).

This fulfills the recited limitation, where the interrogation means, etc., are the combined servers of Morris and Yokomizo as discussed in the rejection to claim 14, and thusly the images would be sent to the third party (the photo finisher) to perform the processing of Carter as recited in the above claim.

Reference Carter teaches the use of processed lenticular images in advertising. It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the images of Carter with the image processing systems of Morris and Yokomizo, since if a public video terminal were equipped with the software as above as taught in claim 1, since mosaic images that were rendered and then sent back to the end user for review, which would happen using the photo-sharing technology of Morris or email, and further the use of the technology of Kimura would allow an advertiser or user to download a picture of a famous event or person (e.g. an athlete), add that image to an advertisement or simply a public display (e.g. a lenticular image) after the end results of the processing operations performed by a third party were complete and the image was returned via the technology of Morris or Yokomizo.

As to claim 16,

A computer network based process as claimed according to claim 14 wherein the third party is able to control the quality of the merged images produced.

References Carter, Morris, and Yokomizo do not explicitly teach this limitation. Reference Kimura teaches that the third party performs image enhancement or resolution conversion [0032], which *prima facie* meets the recited limitations of the above claim. The technology would allow for the systems of the above four references to be used more efficiently and allow the user to have the desired image processed in different ways to achieve a more aesthetically pleasing end result. The motivation and combination of claim 15 is hereby incorporated via reference without further comment.

Claims 17-19 are rejected under 35 U.S.C. 103(a) as unpatentable over Carter, Morris, Yokomizo, and Kimura as applied to claim 16 above, and further in view of Ginter et al (US PGPub 2004/0054630 A1)('Ginter').

As to claim 17,

A computer network based process as claimed according to claim 15, wherein the third party is a licensor of the process for the creation of the merged digital image and selectively control access and use of the process through license agreements with at least one licensee.

References Carter, Morris, and Yokomizo do not explicitly teach this limitation. Reference Kimura implicitly teaches this limitation, in that the third party controls access to the process, but does not teach intellectual property specifically licensed as a process (e.g. the images themselves are controlled, and the higher resolution versions). Reference Ginter teaches licensing of intellectual property with licensees (see, for

example, 0010 and 0023), where intellectual property is defined to include software (0007) that could execute the processes of Carter, and that license agreements control access to content and functionality (0015-0026, various types of entities that would subscribe to such functionality, how it can be applied to almost any circumstance, etc.) In 0630 Ginter discloses the specific use of DRM / VRE software to control the actions of a licensee, including enforcing audit procedures required for a licensee, etc. Clearly, the process of Ginter could be applied to any kind of information services provided over networks, etc, as in the combination of the systems of Morris and Yokomizo as covered in the rejections to claims 14 and 16, and the business model would be obvious, as this is taught by Ginter, and is only an obvious extension of what was rejected under claim 16 above, which rejection is hereby incorporated by reference in its entirety. Finally, Ginter clearly establishes that users pay royalties / license payments for use of content because of the VRE software – e.g. 0200 and 1821.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the processes of Delhi and DeLeeuw with the systems of Morris and Yokomizo for delivery and transmission purposes, along with the content management structures and business methods of Ginter and Kimura (the motivation and combination from claim 16 is hereby incorporated by reference), as the addition of the electronic rights protection and management as well as the business models of Ginter to those of Kimura would enable the third party to control the use and access to such material with the protective attributes of the VRE software, which would enhance the protection given to such images (and processes) via the system of Kimura.

As to claim 18,

A computer network based process as claimed according to claim 17 wherein according to the license agreement, the third party/licensor collects income in the form of license or royalty payments from licensees, according to predetermined parameters of the base images or merged images. [First 3 references do not explicitly teach these limitations (e.g. Carter, Morris, and Yokomizo).]

Clearly, as discussed in the rejection to claim 16 above, the third party does collect income from the user or individual who submitted the images to be processed under the system of Kimura. As taught in Ginter and discussed in the above rejection to claim 17, license payments and royalties are paid out on use of content as per license agreements as covered 0015-0025. Ginter teaches predetermined parameters or the payment for aspects thereof in (0161, 0211, 1912, 1936) for content, which would *prima facie* include images. Therefore, all the limitations are met as recited above. The motivation and combination of the parent claim are hereby incorporated via reference in their entirety.

As to claim 19,

A computer network based process as claimed according to claim 17 wherein the third party / licensor is able to accurately track individual merged images and the quantity of base images and/or merged images output for a particular operator/licensee. [First 3 references do not explicitly teach these limitations (e.g. Carter, Morris, and Yokomizo).]

Clearly, as discussed in the rejection to claims 16 and 17 above, particularly that of claim 16, reference Kimura teaches that for the user to get anything other than a

thumbnail version of the image, they have to compensate the copyright owner, which would fulfill the recited limitations, since every use of the content would have to be paid for and pass through an external server for validation (e.g. the services of Morris and Yokomizo). Further, Ginter clearly teaches the ability to track the number of uses of an object (0404-0411) [tracking quantity of base images input would be *prima facie* obvious and a trivial modification, as it would simply require counting the number of files submitted to the licensee for processing per run of the process for generating the mosaics]. Further, in 0404-0411 Ginter teaches the use of "meter" software that can monitor all the circumstances of use of a licensed piece of process, software, intellectual property, etc. that specifically meets all the limitations recited by applicant. The motivation and combination of claim 17 is hereby incorporated herein by reference in its entirety, in addition to the above-discussed motivation.

It would have been obvious to one having ordinary skill in the art at the time the invention was made to combine the processes of Carter with the systems of Morris and Yokomizo for delivery and transmission purposes, along with the content management structures and business methods of Ginter and Kimura (the motivation and combination from claim 16 is hereby incorporated by reference), as the addition of the electronic rights protection and management as well as the business models of Ginter to those of Kimura would enable the third party to control the use and access to such material with the protective attributes of the VRE software, which would enhance the protection given to such images (and processes) via the system of Kimura.

### **Conclusion**

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Eric Woods whose telephone number is 571-272-7775. The examiner can normally be reached on M-F 7:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ulka Chauhan can be reached on 571-272-7782. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Eric Woods

April 17, 2006

  
ULKA CHAUHAN  
SUPERVISORY PATENT EXAMINER